RECORD AND BRIEF

No. 15-1293

In the

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

AMICI CURIAE BRIEF OF THE THOMAS JEFFERSON CENTER FOR THE PROTECTION OF FREE EXPRESSION AND THE ELECTRONIC FRONTIER FOUNDATION IN SUPPORT OF RESPONDENT

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STATEMENT OF INTEREST OF *AMICI CURIAE*[1]

The Thomas Jefferson Center for the Protection of Free Expression is a nonprofit, nonpartisan organization located in Charlottesville, Virginia. Founded in 1990, the Center has as its sole mission the protection of free speech and press. The Center has pursued that mission in various forms, including the filing of *amicus curiae* briefs in this and other federal courts, and in state courts around the country.

The Electronic Frontier Foundation ("EFF") is a non-profit, civil liberties organization working to protect rights in the digital world. EFF actively encourages and challenges industry and government to support free expression, privacy, and openness in the information society. Founded in 1990, EFF is based in San Francisco.

EFF believes that free speech is a fundamental human right, and that freedom of the press is vital to an open, democratic society. The vast web of electronic media that now connects us is heralding a new age of

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[1] Pursuant to Supreme Court Rule 37.6, counsel for *Amici Curiae* represents that it entirely authored this brief and no party, its counsel, or any other entity but *Amici* and their counsel made a monetary contribution to fund the brief's preparation or submission. Consent of the parties to file this brief is on file with the Court.

communications, a new way to convey speech. New digital networks offer tremendous potential to empower individuals in an ever-overpowering world. While EFF is mindful of the serious issues that may arise when information flows free, EFF is dedicated to addressing such matters constructively while ensuring that fundamental rights are protected.

SUMMARY OF ARGUMENT

The United States Patent and Trademark Office (PTO) seeks to turn First Amendment law on its head. Presently, government regulation of speech based on its viewpoint and content is subject to strict scrutiny. Yet the PTO claims its registration process is government speech and that it can deny a governmental benefit in service of communicating its message. Were this interpretation of the law correct, it would obliterate First Amendment doctrines that sharply limit how the government regulates speech, including prior restraint and time, place and manner restrictions.

The PTO would create a new category of government speech heretofore unrecognized by this Court: speech in which the speaker is private and the message is private, but which by the mere act of registering such expression under a government program, is converted into government speech. In recog-

nizing a trademark, it claims, the government involves itself with private speech and thereby creates government speech.

In virtually every other context, the government's denial of a benefit to a private speaker in order to prevent the speaker from disparaging unrelated persons is plainly unconstitutional. There is no reason to treat the PTO's registration process any differently. Indeed, the idea that the PTO, of all governmental agencies, should be the one charged with discriminating against speech on the basis of viewpoint is completely unfounded, given that agency's purpose and expertise.

That registered trademarks are not government speech flows naturally from this Court's recent decision in *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015). Unlike the specialty and personalized license plates at issue in *Walker*, trademark registrations are not a traditional medium for government speech. There is no clear government speaker in a trademark registration, and the public is unlikely to be confused as to whether the owner or the government is speaking through a trademark. Lastly, because *Walker* relied on the government's essential role in the issuance of license plates, its reasoning does not map naturally onto trademarks. Trademarks serve only to memorialize interests in private speech, whereas license plates convey direct government messages or private speech with which the government has allowed itself to be associated.

ARGUMENT

I. The *Walker* Factors Should be Interpreted as Sharply Limiting the Reach of Government Speech

This case represents an attempt by the PTO to expand the government speech doctrine beyond what this Court intended, and in a manner, that poses a serious threat to the First Amendment rights of private individuals. When a particular type of speech is deemed to be government speech it is effectively shielded from First Amendment review. *Walker*, 135 S. Ct. at 2245–46. Given the potential for abuse this represents the government speech doctrine should be narrowly defined; far more so than it would have to be to encompass trademark registration.

The *Walker* decision used three factors to identify government speech: history, speaker identity, and governmental control. In cases that involve private speech, these factors—even combined—do not reach very far beyond personalized license plate design and certainly not to trademark registration.

A. History Counsels Against Registration as Government Speech

Contexts where private speech is converted to government speech ought to be limited to existing examples such as public monuments and license plates. Unlike monuments and license plates, trademarks do not have a history of being used as a vehicle for government speech. *See Pleasant Grove City v. Summum*, 555 U.S. 460, 470 (2009). ("Governments have long used monuments to speak to the public."); *Walker*, 135 S. Ct. at 2248 ("State speech has appeared on Texas plates for decades."). Trademarks, by contrast, have long been used for commercial purposes by private parties seeking to help people identify their products. The singular purpose of trademark enforcement is to protect consumers and producers. *See Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 163–64 (1995). These messages have always been regarded as private and no reasonable observer would interpret a trademark as a government endorsement of or association with the mark's message. *Cf. Capitol Square Rev. & Advisory Bd. v. Pinette*, 515 U.S. 758, 778, 780 (1995).

B. No Reasonable Consumer Would Confuse Trademarks for Government Speech

The government and supporting *amici* claim that the granting and publication of trademarks by the PTO causes the public to believe that trademarks

are the government's words rather than those of a private business referring to its goods or services. The approval and publication of federal trademark registration in the Principal Register is a formal administrative procedure that results in a catalog of private speakers and their speech. This record exists to identify the property right, name its possessor, and put future registrants on notice that the property right is already possessed and accounted for. As such, it is highly unlikely that publishing this record would cause the trademarks themselves to be viewed as government speech.

It is also claimed that the right to inform people about a trademark's registration status, through the use of the ® or equivalent language by trademark holders, is somehow an "official association with the United States government." Br. for South Asian Bar Ass'n of D.C. as Amici Curiae Supporting Appellant, *In re Simon Shiao TAM*, 2015 WL 4537349 at *4, (C.A.Fed. July 23, 2015). It is difficult to see how a reasonably informed person would think that the ® is representative of such an association. In practice, registration symbols are no different from "no trespassing" signs. Both signal the existence of private legal rights as well as the owner's will and intent to enforce those rights if the protected property is violated. The message conveyed by a "no trespassing" sign is the same regardless of whether the warning is handwritten by the property owner himself or printed by a third party—even if that party happens to be the govern-

ment. The attachment of government-provided symbols to real or intellectual property is no indicator of state involvement in those matters just as applying government-produced postage stamps (even those that feature their own highly expressive designs and messages) to an envelope prior to mailing results in no confusion over the authorship of the letter inside. Despite the PTO's assertions to the contrary, a trademark owner's message and identity are perfectly clear to all reasonable observers and there exists no legitimate concern over the identity of the speaker or any hidden message of government approval.

C. "Direct Control" and Veto Power

The third factor in the *Walker* inquiry is whether, through the review process in question, the government "maintains direct control" over particular messages. *Walker*, 135 S. Ct. at 2249. *See also Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 561 (2005) (discussing instances where the agency "exercises final approval authority over every word used in every promotional campaign"). This examination was necessary in *Walker* because the peculiar characteristics of custom license plates implicate issues of mixed government and private speech that could confuse the public as to the speaker's identity. Direct control over the content of speech or the veto power over such speech is irrelevant when the speaker is purely private. In fact, direct control over purely private speech is exactly what the First Amendment forbids.

The approval of a license plate design only superficially tracks with the PTO's process. In *Walker*, the presence of mixed government/private speech was predicated on the finding that license plates were traditional vehicles of government speech, into which some limited public input had been invited. *See Walker*, 135 S. Ct. at 2248 ("First, the history of license plates shows that, insofar as license plates have conveyed more than state names and vehicle identification numbers, they long have communicated messages from the States.") Trademarks, by contrast, are a private right arising from the common law to memorialize private interests in private speech. *Qualitex*, 514 U.S. at 163–64. *Walker* stands for the notion that the government can surrender some control over its own speech while retaining the right to veto such speech if it so chooses. The PTO implicitly reads this holding in reverse: that the government can assert a discretionary veto over traditionally private speech and thereby convert that speech into government speech.

II. Free Speech Policy Concerns Strongly Counsel Against Treating Trademark Registration as Government Speech

A. This Court Has Rightfully Been Cautious with Government Speech Doctrine

This Court has repeatedly stated that when exercising discretion in regulating private speech the government must "respect[] the critical difference" between "government speech . . . and private speech." *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 841 (1995) (quoting *Bd. of Educ. v. Mergens*, 496 U.S. 226, 250 (1990) (opinion of O'Connor, J.)). In *Summum*, this Court expressed "legitimate concern that the government speech doctrine not be used as a subterfuge for favoring certain viewpoints." 555 U.S. at 462. Justice Stevens went on to note that, "to date, our decisions relying on the recently minted government speech doctrine to uphold government action have been few and, in my view, of doubtful merit." *Summum*, 555 U.S. at 481 (Stevens, J., concurring). Such hesitation remains justified: once given doctrinal force, government speech is hard to limit.

This Court has confined its use of the government speech doctrine to limited circumstances such as when "a government maintains a monument," *Summum*, 555 U.S. at 486 (Souter, J., concurring), or issues license plates, *Walker*, 135 S. Ct. at 2253.

Trademarks are not like those cases. *The Slants* do not propose to speak for the government, nor the government for *The Slants*. Without trademark approval, *The Slants* will still hold themselves out as *The Slants*. All that is withheld here is a government benefit—for viewpoint based reasons. Indeed, the PTO now invokes a capacious interpretation of "govern-

ment speech" that would give it an unaccountable degree of discretion. *See* Pet'r's Br. at 14–19, Lee v. Tam, 137 S. Ct. 30 (2015) (No. 15–1293) (characterizing the government speech aspect of their argument as finding "eligibility for a government program."). If, by some Midas-like transformative touch, the mere act of registering a name converts private speech into government speech, it would enable the simple act of registration to excuse untold encroachments on the First Amendment freedom of speech.

B. Even if the Government in Some Way Speaks by Registering a Trademark, the Government's Message is Necessarily Limited

To the extent the PTO communicates when it registers a trademark, its message is that the trademark is a means by which "goods of the applicant may be distinguished from the goods of others." 15 U.S.C. § 1052. A decision of the PTO, and even notification of the decision, merely serves to inform the mark holder of the outcome and inform other parties as to the rights of the applicant—nothing more. That the PTO allowing or disallowing registration lends a government imprimatur has been expressly denied as "erroneous." *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219–20 n.3 (T.T.A.B. 1993).

In one limited sense that means the government may be speaking via a purely regulatory act, but

in that context the message is only "we grant this permit." If the government also wishes to say "and we don't like this message," they can do that too; but not in the registration context. The PTO cannot deny a permit on the basis of the content or viewpoint of an applicant's speech. Courts have consistently refused to allow cities to engage in viewpoint discrimination by denying parade permits to certain hate groups despite concerns that observers would falsely assume that the city endorsed the group's message. *See, e.g.*, *Invisible Empire of Knights of Ku Klux Klan v. Mayor of Town of Thurmont*, 700 F. Supp. 281 (D. Md. 1988). But surely governments do not want their granting of a permit to the KKK to mean "We endorse this speech" as the PTO suggests its registration process does.

C. Trademark Registration Does Not Fit into the Category of Government Speech by Means of Spending

Although this Court has considered the use of government resources to endorse private speech when identifying government speech, *see, e.g.*, *Summum*, 555 U.S. 460, there is no such endorsement in this case. The publication of trademarks in the Principle Register and the issuance of certificates are at most trivial expenditures and cannot be taken seriously as a government spending issue. That is in no way analogous to the government having to pay for the installation and maintenance of the donated Ten Commandments monument in *Summum*. To the contrary, all of

the significant expenditures, and corresponding financial benefits are by the trademark applicants and holders. Trademark holders are expected to privately fund the enforcement of their trademarks.

The government's argument that Mr. Tam seeks to compel registration and publication of his mark in violation of public policy is misguided. Mr. Tam is not forcing the government to convey a private message that it does not agree with. Registered marks serve to describe brands and identities owned by private participants, not to impute some proprietary government interest. Unlike the Texas DMV in *Walker*, the PTO here controls neither the speech nor the speaker: it merely punishes certain speakers by refusing to confer a legal benefit because it disfavors the content of the speech.

D. The Government Does Not Create Trademarks and Is Thus a Poor Judge of Their Expressive Content

Purely private speech conveys many messages. For that reason, the PTO cannot easily evaluate those messages with objective standards. Commercial businesses, non-profits, and individuals choose company and product names for a variety of reasons. Since the government is not involved in these choices, it will have little understanding of why marks were chosen

and may not understand their expressive content. Indeed, the government's own brief includes a mistake about the expressive content of the "GOOGLE" trademark. The government suggests that the mark is simply a nonsense word "with no preexisting meaning." *See* Pet'r's Br. at 47. But "GOOGLE" is play on the word "googol," which is the name for the very large number 10^{100}. The founders of Google chose their company name to reflect their "mission to organize a seemingly infinite amount of information on the web." *See* Google, *Our History in Depth*, https://www.google.com/about/company/ history. Contrary to the government's supposition, many in the engineering and science world are familiar with the deeper meaning of the mark. That the government's brief in this very case includes an error about the meaning of a world-famous trademark drives home just how bad a judge it is of the expressive content of trademarks.

Beyond simply misunderstanding blatant double-meanings such as "GOOGLE," the government also on occasion finds unintended double-meanings as the basis for rejecting a mark. In this case and others, the PTO denied a trademark registration by imagining unintended interpretations, contexts, and scenarios in which a proposed mark would give offense, and used such conjectures as the basis for rejecting the mark, regardless of the speaker's meaning or the speech actually conveyed by the mark. One example is particularly salient. In reviewing the Lebanese Arak Corporation's application to register "KHORAN"

wine, the Trademark Trial and Appeal Board (TTAB) refused to grant the trademark. The TTAB reasoned that because "khoran," an Armenian word meaning "altar," was a homophone of the Islamic holy book (the Koran), and since the Koran forbids consumption of alcoholic beverages, the mark "KHORAN" could offend followers of the Islamic faith. *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2D 1215 (T.T.A.B. 2010). In fact, the words "Armenian Wine" appeared "prominently on the wine bottle specimen label," but that feature was considered "essentially irrelevant" to the question of how consumers would understand the label "KHORAN." *Id.* at 7. The speaker's intent behind the mark and the message itself ceased to be treated for what they were: private speech.

The government wrongly dismisses the expressive content of marks as "incidental." *See* Br. in Opp'n at 47. Certainly, a trademark may have little or no independent expressive content aside from its role as a source identifier. But many marks can have deep expressive meaning to both the applicant and the public. Far from merely serving as source identifiers, many trademarks are so imbued with expression that scholars have suggested that the expressive meaning of a mark, standing alone, can be the primary driver of consumer behavior. *See generally* Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. Rev. 621, 667–70 (2004). The government not only fails to understand this rich and complex expression, it radically compounds its error by claiming it as its own speech.

Further, the inconsistent record of the PTO in granting colorful and sometimes genuinely offensive marks but denying benign ones, belies any notion that the PTO is not associating itself with messages it finds offensive or with which it disagrees. *See, e.g.*, RADICALLY FOLLOWING CHRIST IN MISSION TOGETHER (U.S. Reg. No. 4,759,522); THINK ISLAM (U.S. Reg. No. 4,719,002) (religious marks); GANJA UNIVERSITY (U.S. Reg. No. 4,070,160) (drug-related); CAPITALISM SUCKS DONKEY BALLS (U.S. Reg. No. 4,744,351); TAKE YO PANTIES OFF (U.S. Reg. No. 4,824,028); and MURDER 4 HIRE (U.S. Reg. No. 3,605,862). *See also Tam*, 808 F.3d at 1346. Ultimately, the government cannot logically have it both ways: either trademark registration converts trademarks into government speech, in which case trademarks that seemingly advance a particular religion or encourage illegal activities should be prohibited, or it does not. Given this inconsistent application and demonstrated lack of comprehension, it is deeply troubling that the existing scheme hinges on the government's understanding of the meanings of trademarks.

E. PTO's Trademark Review Cannot Shield Arbitrary and Discriminatory Findings from First Amendment Scrutiny

The government cannot claim an expressive interest in approving or denying trademarks when the

purported content of those marks is so contingent on individual examiners' caprice. Beyond providing evidence of administrative incompetence, the government's interpretations of "GOOGLE" and "KHORAN" demonstrate the incoherence of treating their often implausible or incorrect interpretations of proposed marks as authoritative. Far from applying an objective test, TTAB asserts broad discretion in determining what it believes to be a "substantial composite of the referenced group." *In re Lebanese Arak Corp.* at *3. In the case of the "KHORAN" mark, for instance, the PTO asserted without support that the mark referenced Muslims, an assertion that TTAB took as a given. *Id.* at *4. To make matters worse, the term "may be disparaging to" establishes the lowest possible standard of proof for examining attorneys who can gin up pseudo-research from blogs, comments, and obscure dictionary references to deny trademarks that have highly contextual meanings. *See* Examining Att'y's Appeal Br. at 1*, *Simon Shiao TARN [sic]*, 2013 WL 6039240 (T.T.A.B. 2013) (Opp'n No. 85472044).

A registration process that serves as the government's airing of its views regarding disparagement is inconsistent with the purpose of both the PTO and trademark law in general. The purpose of trademarks is to prevent consumer confusion and to give mark holders the opportunity to find creative ways to distinguish their products. *See Qualitex*, 514 U.S. at 163–64. Viewpoint discrimination has nothing to do with the proper goals of trademarks. This is not a situation such as that in *Rust v. Sullivan*, 500 U.S. 173 (1991),

where Congress crafted a program to fund the dissemination of specific message, in the process excluding the recruited speakers from using the funds to communicate an inconsistent message. *See id.* at 174–75 ("Similarly, in implementing the statutory prohibition by forbidding counseling, referral, and the provision of information regarding abortion as a method of family planning, the regulations simply ensure that appropriated funds are not used for activities, including speech, that are outside the federal program's scope.").

The Court could clarify this distinction by reasserting that "even though a person has no 'right' to a valuable governmental benefit" and the government "may deny . . . the benefit for any number of reasons . . . [i]t may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech." *Perry v. Sindermann*, 408 U.S. 593, 597 (1972). *See also Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 587 (1998) (noting that even in the provision of subsidies, the government may not "aim at the suppression of dangerous ideas"). There is no doubt that the benefits of registration are being withheld from constitutionally protected speech and the Respondent's brief addresses the unconstitutional conditions doctrine. However, this reasoning equally applies to simple viewpoint discrimination concerns. When the government regulates private speech that is protected under the Constitution it may not do so on the basis of

viewpoint. First Amendment review should not be ignored in a case in which the regulation of private speech is so squarely indicated.

F. Courts Can Balance Speech Interests Implicated by the Lanham Act Without Mislabeling Trademarks as Government Speech

A number of *amici* supporting the government have noted that any trademark regime must balance the free speech rights of both trademark owners and the public. These *amici* explain that trademark enforcement can burden expression. *See* Br. of Law Professors as Amici Curiae in Support of Pet'r at 25 (noting that the "the entire system of trademark registration is a system of speech regulation"); Br. of Amicus Curiae Public Knowledge in Support of Neither Party at 11–14. We agree.[2] The potential misuse of registered marks, however, does *not* require trademark

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[2] The Electronic Frontier Foundation has filed *amicus* briefs and represented clients in numerous similar cases where abusive trademark enforcement threatened free speech. *See e.g.*, Daniel Nazer, *Deeplinks Blog: EFF to Court: A Trademark is Not a Censorship Tool*, Electronic Frontier Foundation (Oct. 11, 2014), https://www.eff.org/deeplinks/2014/10/eff-court-trademark-not-censorship-tool; Daniel Nazer, *Deeplinks Blog: EFF to Jones Day: Don't Be A Trademark Bully*, Electronic Frontier Foundation (June 24, 2014), https://www.eff.org/deeplinks/2014/06/eff-jones-day-dont-be-trademark-bully.

registration to be elevated to government speech in the way the PTO suggests. Other long-established doctrines can be invoked to protect the public from overbroad trademark enforcement.

A comparison with defamation law is instructive. Most defamation lawsuits, like most trademark lawsuits, are between private parties. But defamation statutes and judicial orders in defamation cases are considered an exercise of state power. *See N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 265 (1964). Accordingly, the First Amendment limits the reach of defamation law. *Id.* at 283–84. There is no need to assume that defamation is government speech to arrive at this result. Similarly, there is no need to assume trademark registration is government speech for courts to apply the First Amendment to protect speakers from overbroad trademark enforcement.

This reasoning resolves a concern expressed by an *amicus* before the Federal Circuit. There, the *amicus* argued that, if Mr. Tam were to prevail, hate groups might register trademarks on hateful speech and assert those marks in a way that restricted the speech of those that would publicize and criticize the conduct of such groups. *See* Br. for South Asian Bar Ass'n of D.C. as Amici Curiae Supporting Appellant, *In re Simon Shiao Tam*, 2015 WL 4537349 at *4, (Fed. Cir. June 23, 2015) (suggesting that "the hate group would be able to call upon the power of the government courts to cut off lawful speech by the counter-group aimed at subverting the message of hate"). In

support of this argument, the South Asian Bar Association of Washington, D.C. compared the registration of disparaging marks to the recording of racially restrictive covenants. *Id.* It suggested a ruling for Mr. Tam might be inconsistent with *Shelley v. Kraemer*, 334 U.S. 1 (1948).

This is not correct. In *Shelley*, this Court found "state action" where private parties resorted to the state courts to enforce a facially discriminatory restrictive covenant. That holding, as in *Sullivan*, is premised on the application of state power by courts. It did not rely on racially restrictive covenants being categorized as government speech. The lesson from *Shelley* is that courts can protect constitutional rights without improperly categorizing private agreements or private speech as belonging to the government. Any court faced with trademark enforcement that improperly burdens speech should invoke the First Amendment and refuse to allow a trademark to be asserted in such a manner. *See Koch Industries, Inc. v. Does*, No. 2:10CV1275DAK, 2011 WL 1775765 at *5 (D. Utah May 9, 2011) (declining to allow trademark owner to assert mark against a website critical of its conduct).

CONCLUSION

For the foregoing reasons, *amici* urge the Court to deny that trademark registration is government

speech and thereby consider the First Amendment concerns raised in this case.

Respectively Submitted,

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